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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/047,307	01/15/2002	Thomas E. Murphy JR.	END920010094US1	5180
23550	7590	01/24/2007	EXAMINER	
HOFFMAN WARNICK & D'ALESSANDRO, LLC			LIVERSEdge, JENNIFER L	
75 STATE STREET			ART UNIT	PAPER NUMBER
14TH FLOOR			3692	
ALBANY, NY 12207				
SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE		DELIVERY MODE	
3 MONTHS	01/24/2007		PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)
	10/047,307	MURPHY ET AL.
	Examiner	Art Unit
	Jennifer Liversedge	3692

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 15 January 2002.
 2a) This action is **FINAL**. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-26 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-26 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 15 January 2002 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO/SB/08)
 Paper No(s)/Mail Date 1/15/2002.
- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____.
 5) Notice of Informal Patent Application
 6) Other: _____.

DETAILED ACTION

Specification

The disclosure is objected to because of the following informalities:

Page 5, line 21 should refer to "...in the context of an intended..." rather than "...in the context an intended...".

Page 10, line 15 should refer to "...alert code to the..." rather than "...alert code the...".

Page 11, line 20 should refer to "...message reception system 28..." rather than "...message reception system 26...".

Page 11, line 20 should refer to "...which is similar..." rather than "...which similar...".

Appropriate correction is required.

Drawings

The drawings are objected to because Figure 1, items 22, 20, 42 and 44 are not labeled as other items are labeled. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended: The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must

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be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1 and 6 are rejected under 35 U.S.C. 102(e) as being anticipated by Pub. No. US 2002/0161701 A1 to Warmack (further referred to as Warmack).

Regarding claim 1, Warmack discloses a method for receiving an alert code in a commercial transaction (Figures 1-4; pages 1-5), comprising the steps of:

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Using a transactional device in a commercial transaction (page 1 paragraphs 11-12; page 2, paragraph 25; page 3, paragraphs 34 and 39); and

Receiving an alert code attached to transaction data for the commercial transaction (page 1, paragraph 12; page 2, paragraphs 13 and 25; page 3, paragraphs 34 and 39; page 4, paragraphs 43 and 52).

Regarding claim 6, Warmack discloses where in the transactional device is selected from the group consisting of a magnetic device and a machine-readable code containing device (page 1 paragraphs 11-12; page 2, paragraph 25; page 3, paragraphs 34 and 39).

Claims 17-19, 21-24 and 26 are rejected under 35 U.S.C. 102(e) as being anticipated by Hayes.

Regarding claims 17, 19, 22 and 24, Hayes discloses a system and program product stored on a recordable medium for receiving an alert code in a commercial transaction (Figures 1, 2B, 2C, 3B-7; pages 1-6), comprising:

A message reception system for receiving a message (Figures 1, 2B, 2C, 3B-7; pages 1-6);

A recipient identification system for identifying an intended recipient of the message based upon use of a transactional device during a commercial transaction (Figures 1, 2A-2C, 3B-7; pages 1-6);

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An attachment system for attaching an alert code to transaction data for the transaction (Figures 2B-2C; pages 1-6); and

A message transmission system for transmitting the received message (Figures 2B- 2C, 3B-7; pages 1-6).

Regarding claims 18 and 23, Hayes discloses wherein the message reception system records the message, and wherein the message transmission system plays the recorded message (Figures 5B-5E; page 4, paragraph 46).

Regarding claims 21 and 26, Hayes discloses a subscription system and program product for the intended recipient to subscribe to a message service (page 2, paragraph 31; page 3, paragraph 32).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 2-5 and 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Warmack as applied to claim 1 above, and further in view of Pub. No. US 2003/0195811 A1 to Hayes, Jr. et al. (further referred to as Hayes).

Regarding claims 2-5 and 7-9, Warmack discloses:

Receiving a transaction request after the using step (page 1, paragraphs 11-12; page 3, paragraphs 34 and 39-40; page 4, paragraphs 43 and 52);

Attaching an alert code to transaction data in response to the transaction request, prior to the receiving step and sending the alert code attached to the transaction code where the sender is the clearing house and the message is received from the clearing house (page 1, paragraph 12; page 2, paragraphs 13 and 25; page 3, paragraphs 34 and 39; page 4, paragraphs 43 and 52).

Warmack does not disclose contacting a message center with a message to retrieve the message in response to a received alert code, where the alert code is unrelated to the commercial transaction. However, Hayes discloses contacting a message center with a message to retrieve the message in response to a received alert code, where the alert code is unrelated to the commercial transaction (Figures 1, 2B, 2C, 3B-7; pages 1-6).

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It would be obvious to one of ordinary skill in the art to modify the clearing house with message delivery system as disclosed by Warmack to adapt the contacting of a message center with a message prior to a transaction as disclosed by Hayes. The motivation would be that a sender of a message knows that messages are going to be dispatched by a clearing house upon being engaged in a transaction, whether those messages are generated at the time of transaction or received prior to conducting a transaction. The clearing house can then be utilized to deliver a multitude of messages in one transaction regardless of whether they are related to any particular transaction or to each other, etc., the clearing house is the hub and distributor of messages of varying types and originators.

Warmack does not disclose wherein the alert code is appended or prepended to the transaction code. However, given the combination of Warmack and Hayes, it would be obvious that the alert code would be appended or prepended to the transaction code, the motivation being that as messages regarding the transaction as well as messages not regarding the transaction are being submitted to the user together, these codes will be together in various arrangements.

Claims 10-12, 14-16, 20 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hayes.

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Regarding claim 10-12, 20 and 25, Hayes discloses a method, system and program product for receiving an alert code in a commercial transaction (Figures 1, 2B, 2C, 3B-7; pages 1-6), comprising the steps of:

Contacting a message center with a message (Figures 1, 2B, 2C, 3B-7; pages 1-6);

Using a transactional device in a commercial transaction (Figures 1, 2B, 4C—5B, 6A-7; pages 1-6);

Identifying an intended recipient of the message (Figures 1, 2A-2C, 3B-7; pages 1-6);

Attaching an alert code to transaction data for the transaction (Figures 2B-2C; pages 1-6);

Receiving the alert code attached to the transaction data (Figures 2B- 2C, 3B-7; pages 1-6); and

Retrieving the message in response to the received alert code (Figures 2B- 2C, 3B-7; pages 1-6).

Hayes does not disclose wherein the alert code is unrelated to the transaction. It would be obvious to one of ordinary skill in the art that the message distribution center as disclosed by Hayes could be used to dispatch messages of all varieties. The motivation would be that a sender of a message knows that messages are going to be dispatched by a clearing house upon being engaged in a transaction, whether those messages are related to a particular transaction or not. The message center can then be utilized to deliver a multitude of messages in one transaction regardless of whether

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they are related to any particular transaction or to each other, etc., the message center is the hub and distributor of messages of varying types and originators.

Regarding claims 14-15, Hayes does not specifically disclose wherein the alert code is appended or embedded to the transaction code. However, it would be obvious that the alert code would be appended or embedded to the transaction code, the motivation being that as messages regarding the transaction as well as messages not regarding the transaction are being submitted to the user together, these codes will be together in various arrangements.

Regarding claim 16, Hayes discloses alerting a transaction clerk of the contact (page 6, paragraph 56).

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hayes as applied to claim 10 above, and further in view of Warmack.

Hayes does not disclose wherein the transactional device is a magnetic device. However, Warmack discloses wherein the transactional device is a magnetic device (pages 1-5). It would be obvious to one of ordinary skill in the art to modify the message system by transaction activation mechanism as disclosed by Hayes to adapt the use of credit cards as a transactional device as disclosed by Warmack. The motivation would be that frequently credit cards are included in PDAs, phones, etc. and

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as Warmack notifies when a credit card is used, Hayes knows when a system is on-line and can send notification as to that information. Accordingly, integrating the use of credit cards as disclosed by Warmack with the system as disclosed by Hayes would enable messages to be sent when a device and it's components are in active mode.

Conclusion

Any inquiry concerning this communication should be directed to Jennifer Liversedge whose telephone number is 571-272-3167. The examiner can normally be reached on Monday – Friday, 8:30 – 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached at 571-272-6777. The fax number for the organization where the application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jennifer Liversedge

Examiner

RICHARD E. CHILCOT, JR.
SUPERVISORY PATENT EXAMINER
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